



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,507	06/26/2003	G. Thomas Athens	F-703	5201

7590 06/15/2009
Pitney Bowes Inc.
Intellectual Property and Technology Law Dept.
35 Waterview Drive
P.O. Box 3000
Shelton, CT 06484

EXAMINER

MURDOUGH, JOSHUA A

ART UNIT	PAPER NUMBER
----------	--------------

3621

MAIL DATE	DELIVERY MODE
-----------	---------------

06/15/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/606,507	Applicant(s) ATHENS ET AL.	
	Examiner JOSHUA MURDOUGH	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-15, 18-27, 29-32, 42, and 43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-15, 18-27, 29-32, 42, and 43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination (“RCE”) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 24 March 2009 has been entered.

Acknowledgements

2. This action is responsive to Applicants' RCE noted above and the associated amendments received 24 March 2009.
3. This action has been assigned paper number 20090605 for reference purposes only.
4. Claims 12-15, 18-27, 29-32, 42, and 43 are pending and have been examined.

Specification

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. §1.75(d)(1), and MPEP §608.01(o), and MPEP §2181 IV. and its discussion of 37 C.F.R. §1.75(d). Correction of the following is required:

- a. The “means for processing a first audit record, said audit record, and usage data” as recited in claim 25.

Appropriate correction is required.

Claim Objections

6. Claims 14 and 27 are objected to under 37 C.F.R. §1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicants are required to cancel the claims, or amend the claims to place the claims in proper dependent form, or rewrite the claims in independent form. Claims 13 and 26, from which these claims depend, recite “verifying the time stamp in the first audit record corresponds to the start of the audit period” and “verifying the time stamp in the second audit record corresponds to the end of the audit period.” These limitations show that the time stamps are verified, e.g. they are correct. However, claims 14 and 27 recite that they do not correspond. Applicants have presented an alternate definition for the word “verify.” The Examiner has considered the definition. However, the Examiner is not required to use a definition provided by Applicants unless it is a lexicographic definition presented in the disclosure of the application with sufficient clarity, precision, and deliberateness. It is the Examiner’s position that there is no such definition in Applicants’ disclosure. Therefore, the Examiner is to make the presumption that terms are to be given their broadest reasonable interpretation. When there is an issue under any reasonable interpretation it is the Examiner’s duty to point out this issue. The Examiner respectfully suggests incorporating appropriate sections of the definition into their claims in order to require the desired interpretation.

Claim Rejections - 35 USC § 112 2nd Paragraph

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 12-15, 18-27, 29-32, 42, and 43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. The metes and bounds for claim 12 cannot be ascertained by one of ordinary skill in the art. Claim 12 recites:

if the first and second digital signatures verify, determining a difference between the value of the at least one register at the end of the audit period and the start of the audit period;
comparing the determined difference with corresponding data provided in the usage data; and
if the determined difference correlates with the corresponding data provided in the usage data, generating a usage report for the value dispensing system based on the usage data.

10. The comparing step does not appear to be dependent on the signatures verifying. However, the comparing step uses data (determined difference) that is only calculated if the signatures verify. Therefore, if the signatures do not verify, one of ordinary skill in the art would not understand if they are to perform the comparing step and if so, whether the difference should have been calculated in spite of the recitation to the contrary.

11. It appears that Applicants' intent may have been that if the first if is not satisfied (signatures do not match), the remaining steps are not performed. In such a situation the above quoted limitations would not need to be satisfied to infringe, anticipate, or render obvious. The Examiner previously took the position that the limitation "verifying the first and second digital signatures" found just prior to the above limitations required the signatures to match. However, Applicants' have argued that they intended verify to mean "to test or check the accuracy or correctness of, as by investigation, comparison with a

standard, or reference to the facts." Thus, this position is no longer valid. Therefore the limitations "if...comparing...and if..." noted above are considered to be conditional for purposes of applying the prior art.

12. Claim 25 is indefinite because of issues with its invocation of 35 U.S.C. 112 6th paragraph. These issues are as follows:

b. It is unclear which function modifies the phrase "means for." See MPEP 2181 I prong (B). At first it appears that "processing the first audit record, the second audit record, and the usage data" is the function. However, Applicants also recite other functions, (i) through (iv), in claim 25. Applicants have argued that these are part of the means plus function limitation (Remarks, Page 10, Paragraph 3). This makes the metes and bounds of the claim unclear. One of ordinary skill in the art would not understand if they need to have only a means for processing the reports and data or each of a means for verifying, a means for determining, a means for comparing, and a means generating.

In order to clearly set out the means plus function limitation(s) and clearly link and associate them with the corresponding structure(s), Applicants are invited to complete the 35 U.S.C. 112 6th analysis presented below for each element.

c. The claim limitation "means for processing the first audit record, the second audit record, and the usage data" uses the phrase "means for," but it is modified by some structure, material, or acts recited in the claim. It is unclear whether the recited structure, material, or acts are sufficient for performing the

claimed function which would preclude application of 35 U.S.C. 112, sixth paragraph, because steps (i) through (iv) recite the processing to be performed. This processing is what is to be imported from Figure 3 according to Applicants.

If applicant wishes to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that the phrase “means for” or “step for” is clearly **not** modified by sufficient structure, material, or acts for performing the claimed function.

If applicant does **not** wish to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that it will clearly not be a means (or step) plus function limitation (e.g., deleting the phrase “means for” or “step for”).

See the discussion of 35 U.S.C. 112 6th below.

d. Claims 25, 26, 27, and 29, and those depending therefrom, are rejected as being hybrid claims. Claims 26, 27, and 29 depend from and modify the processing of claim 25. According to Applicants' argument, the steps that are part of the processing are part of the means plus function limitation. Therefore, these recitations would not add any structural limitations. However, Applicants' addition of these elements in dependent claims indicates that their intention to add something to the independent claim. Because it is unclear if interpretation under 35 U.S.C. 112 6th is invoked, one of ordinary skill in the art would not understand if the steps in claims 25, 26, 27, and 29 need to be performed or just exist in software.

As the performance of the steps is a reasonable interpretation, a person of ordinary skill in the art could reasonably interpret claim 1 to be drawn to either a product or process.

Therefore, these claims, and those depending therefrom, are indefinite because they are considered hybrid claims. See MPEP §2173.05(p) II. In particular, the claims are directed to neither a “process” or a “machine” but rather embrace or overlap two different statutory classes of invention as set forth in 35 U.S.C. §101.

Therefore in accordance with §2173.05(p) II which states that a single claim must be drawn to either a product or process (but not both) and because a potential competitor of Applicants would not know whether *possession alone* of the claimed structure constituted infringement, or alternatively, if infringement required the *execution* of the recited method steps, the claims are indefinite. If Applicant(s) overcome this particular 35 U.S.C. §112, 2nd paragraph rejection, the related 35 U.S.C. §101 rejection will also be withdrawn.

13. The Examiner finds that because particular claims are rejected as being indefinite under 35 U.S.C. §112 2nd paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claim are indefinite, the claims are construed and the art is applied as much as practically possible.

14. Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which Applicants regard as their invention. Evidence that claim 25 fails to correspond in scope with that which Applicants regard as the invention can be found in the reply filed 24 March 2009. In that paper, applicant has stated "Claim 25 does not positively recite the dispensing device" (Remarks, Page 9, Paragraph 2) and this statement indicates that the invention is different from what is defined in the claim because claim 25 recites "a value of at least one register maintained by the value dispensing device," "the first audit record generated by the value dispensing device," and "the second audit record generated by the value dispensing device." Recitations of the functions performed by the value dispensing device, which are necessary to the processing by the data center amounts to a positive recitation.

Claim Rejections - 35 USC § 101

15. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

16. Claims 25-27, 29-32, and 42 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

17. Claims 25-27, 29-32, and 42 are rejected under 35 U.S.C. 101 because the claim is directed to neither a "process" nor a "machine" but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C 101 which is drafted so as to set the statutory classes of invention in the alternative only.

Claim Rejections - 35 USC § 102

18. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

19. Claims 12, 18-25, 29-32, 42, & 43, as understood by the Examiner, are rejected under 35 U.S.C. §102(e) as being anticipated by Leon (6,424,954).

20. As to claim 12, Leon shows:

receiving a first audit record from the value dispensing device, (signed message,

Figure 5F, 5214)

the first audit record generated by the value dispensing device (“SMD”) at the start of an audit period, the first audit record including a value of at least one register maintained by the value dispensing device at a start of the audit period (Figure 5F, 5214) (Column 18, lines 47-56)

and a first digital signature, (Column 18, lines 47-56 & Column 101, lines 18-20)

receiving a second audit record from the value dispensing device (“SMD”), the second audit record generated by the value dispensing device at the end of the audit period, (signed message, Figure 5F, 5214)

the second audit record including a value of at least one register maintained by the value dispensing device at a end of the audit period, (Figure 5F, 5214) (Column 18, lines 47-56)

and a second digital signature; (Column 18, lines 47-56 & Column 101, lines 18-20)

receiving usage data from the value dispensing device for the audit report; (STATUS message, Column 85, lines 1-6 & following table)

verifying the first and second digital signatures; (Figure 5F, 5218) (Column 61, lines 41-50)

if the first and second digital signatures verify (Column 9, lines 11-20), determining the difference between the value of the at least one register at the end of the audit period and the start of the audit period (Columns 61-62, lines 51-13);

comparing the determined difference with corresponding data provided in the usage data; (Column 46, lines 48-54)

and if the determined difference correlates with the corresponding data provided in the usage data, generating a usage report for the value dispensing system based on the usage data. (Figure 8F, element 890)

21. As interpreted by the Examiner, the reports, according to Leon, are sent at the end of one period, are also considered to be sent at the beginning of the subsequent period. The report at the end of a period must be completed after the period ends so that every transaction from the period is included. Similarly a report at the beginning of a period must be completed before the period begins so that no transactions from the current period are included. Therefore, in reality, the

report does not belong to one transaction period, but to its own reporting period occurring between transaction periods, immediately before one transaction period and immediately after the previous one. (Leon, Figures 5f and 5f-2 show the transition from the registered, or transaction, state to the intermediate, or reporting, state in order to process and report the data and the subsequent return to the registered state when the reporting is finished.)

22. As to claim 18, Leon further shows:

the first audit record is received before the end of the audit period.

23. Again, this is inherent to the periodic auditing process. The first report would have been at the beginning of the audit period as the second report of the previous audit.

24. As to claim 19, the storage and later retrieval of a record previously sent is inherent to a system that compares the record to a later created one.

25. As to claim 20, Leon further shows:

the at least one register value in the first and second audit records includes a plurality of register values. (Column 18, lines 47-56)

26. As to claim 21, Leon further shows:

the at least one register value in the first and second audit records includes an ascending register value. (Column 99, lines 37-41)

27. As to claim 22, Leon further shows:

the at least one register value in the first and second audit records includes a total piece count register value. (Column 100, lines 44-47)

28. As to claim 23, Leon further shows:

the first and second digital signatures are verified utilizing a public key. 536

29. As to claim 24, Leon further shows:

indicating an error in the processing of the usage data. (Figure 6F)

30. As to claim 25, Leon shows:

an interface circuit to receive a first audit record, (Figure 5F, 5214)

a second audit record (Figure 5F, 5214)

and usage data from a value dispensing device, (Column 11, lines 59-61)

the first audit record generated by the value dispensing device at a start of an audit

period including a value of at least one register maintained by the value

dispensing device at the start of the audit period (Figure 5F, 5214) (Column 18,

lines 47-56)

and a first digital signature, (Figure 5F, 5214)

the second audit record generated by the value dispensing device at an end of an audit

period including a value of at least one register maintained by the value

dispensing device at an end of the audit period (Figure 5F, 5214) (Column 18, lines 47-56)

and a second digital signature; (Figure 5F, 5214)

means for processing the first audit record, the second audit record and usage data,

the means for processing the first audit record, the second audit record and usage data being coupled to the interface circuit, the processing including

(i) verifying the first and second digital signatures; (Figure 5F, 5218)

(ii) determining the difference between the value of the at least one register at the end of the audit period and the start of the audit period if the first and second digital signatures verify; (Columns 61-62, lines 51-13);

(iii) comparing the determined difference with corresponding data provide in the usage data (Column 46, lines 48-54), and

(iv) generating a usage report for the value dispensing device based on the usage data if the determined difference correlates with the corresponding data provided in the usage data. (Column 62, lines 14-43)

31. As interpreted by the examiner, the reports, according to Leon, are sent at the end of one period, are also considered to be sent at the beginning of the subsequent period. The report at the end of a period must be completed after the period ends so that every transaction from the period is included. Similarly a report at the beginning of a period must be completed before the period begins so that no transactions from the current period are included. Therefore, in reality, the report does not belong to one transaction period, but to its own reporting period occurring

between transaction periods, immediately before one transaction period and immediately after the previous one. (Leon, Figures 5f and 5f-2 show the transition from the registered, or transaction, state to the intermediate, or reporting, state in order to process and report the data and the subsequent return to the registered state when the reporting is finished.)

32. As to claim 29, the storage and later retrieval of a record previously sent is inherent to a system that compares the record to a later created one.

33. As to claim 30, Leon further shows:

the at least one register value in the first and second audit records includes an ascending register value. (Column 99, lines 37-41)

34. As to claim 31, Leon further shows:

the at least one register value in the first and second audit records includes a total piece count register value. (Column 100, lines 44-47)

35. As to claim 32, Leon further shows:

the first and second digital signatures are verified utilizing a public key. (Figure 5B, 536)

36. As to claims 42 and 43, Leon further shows:

The value dispensing device is a postage meter. (Title)

Claim Rejections - 35 USC § 103

37. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

38. Claims 13-15 as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Leon as applied to claim 12 above, and further in view of Mosher (5,799,322).

39. As to claim 13, Leon further shows:

the first and second audit records each include a respective time stamp, (Column 18, lines 47-56)

40. Leon does not show:

verifying the time stamp in the first audit record corresponds to the start of the audit period;

and verifying the time stamp in the second audit record corresponds to the end of the audit period.

41. Mosher shows the verification of time stamps prior to accepting audit data (Columns 31-32, lines 66-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the invention of Leon to add time stamp validation, because this

would further show that the data was valid for the audit period and not transactions outside of that time, as is done by Mosher (Column 32, 9-59).

42. As to claim 14, Leon further shows:

indicating an error in the processing of the usage data. (Figure 6F)

43. As to claim 15, Leon further shows:

the time stamp includes a date and a time (Column 18, lines 47-56)

44. Claims 26 and 27, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over Leon as applied to claim 25 above, and further in view of Mosher (5,799,322).

45. As to claim 26, Leon further shows:

the first and second audit records each include a respective time stamp, (Column 18, lines 47-56)

46. Leon does not show:

verifying the time stamp in the first audit record corresponds to the start of the audit period; and

verifying the time stamp in the second audit record corresponds to the end of the audit period.

47. Mosher shows the verification of time stamps prior to accepting audit data (Columns 31-32, lines 66-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to have further modified the invention of Leon to add time stamp validation, because this would further show that the data was valid for the audit period and not transactions outside of that time, as is done by Mosher (Column 32, 9-59).

48. As to claim 27, Leon further shows:

49. indicating an error in the processing of the usage data if one of , the time stamp in the first audit record or the second audit record does not correspond. (Figure 6F)

50. Claims 12, 18-25, 29-32, 42, & 43, as understood by the Examiner, are alternately rejected under 35 U.S.C. 103(a) as being unpatentable over Leon in view of Lertzman (US 2004/0006510).

51. As to claim 12 and its dependents, it is the Examiner's primary position that Leon discloses that the digital signatures may not verify. Therefore, the steps of verifying, comparing, and generating would not be performed. However, if a reviewing body determines this not to be, these alternate rejections are provided.

52. As to claim 12, Leon shows:

receiving a first audit record from the value dispensing device, (signed message,

Figure 5F, 5214)

the first audit record generated by the value dispensing device (“SMD”) at the start of an audit period, the first audit record including a value of at least one register maintained by the value dispensing device at a start of the audit period (Figure 5F, 5214) (Column 18, lines 47-56)

and a first digital signature, (Column 18, lines 47-56 & Column 101, lines 18-20) receiving a second audit record from the value dispensing device (“SMD”), the second audit record generated by the value dispensing device at the end of the audit period, (signed message, Figure 5F, 5214)

the second audit record including a value of at least one register maintained by the value dispensing device at a end of the audit period, (Figure 5F, 5214) (Column 18, lines 47-56)

and a second digital signature; (Column 18, lines 47-56 & Column 101, lines 18-20) receiving usage data from the value dispensing device for the audit report; (STATUS message, Column 85, lines 1-6 & following table)

verifying the first and second digital signatures; (Figure 5F, 5218) (Column 61, lines 41-50)

if the first and second digital signatures verify (Column 9, lines 11-20),

and if the determined difference correlates with the corresponding data provided in the usage data, generating a usage report for the value dispensing system based on the usage data. (Figure 8F, element 890)

53. Leon does not expressly show:

determining the difference between the value of the at least one register at the end of the audit period and the start of the audit period;
comparing the determined difference with corresponding data provided in the usage data;

54. However, Lertzman teaches usage data (“detail transaction data” [0075]) being compared to the difference between the value at the end of a period and the start of the period (“summary transaction data”). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Leon to include the validation as taught by Lertzman in order to verify the remittance is proper for the transactions completed (Lertzman, [0075]).

55. As to claim 18, Leon further shows:

the first audit record is received before the end of the audit period.

Again, this is inherent to the periodic auditing process. The first report would have been at the beginning of the audit period as the second report of the previous audit.

56. As to claim 19, the storage and later retrieval of a record previously sent is inherent to a system that compares the record to a later created one.

57. As to claim 20, Leon further shows:

the at least one register value in the first and second audit records includes a plurality of register values. (Column 18, lines 47-56)

58. As to claim 21, Leon further shows:

the at least one register value in the first and second audit records includes an ascending register value. (Column 99, lines 37-41)

59. As to claim 22, Leon further shows:

the at least one register value in the first and second audit records includes a total piece count register value. (Column 100, lines 44-47)

60. As to claim 23, Leon further shows:

the first and second digital signatures are verified utilizing a public key. 536

61. As to claim 24, Leon further shows:

indicating an error in the processing of the usage data. (Figure 6F)

62. As to claim 25 and its dependents, it is the Examiner's primary position that the functional limitations (i)-(iv) should not be given patentable weight as "apparatus claims cover what a device *is*, not what a device *does*" (MPEP § 2114) (emphasis in original). Therefore, the steps of verifying, determining, comparing, and generating would not need to be performed to

have infringement/anticipation. However, if a reviewing body determines this not to be, these alternate rejections are provided.

63. As to claim 25, Leon shows:

an interface circuit to receive a first audit record, (Figure 5F, 5214)

a second audit record (Figure 5F, 5214)

and usage data from a value dispensing device, (Column 11, lines 59-61)

the first audit record generated by the value dispensing device at a start of an audit

period including a value of at least one register maintained by the value

dispensing device at the start of the audit period (Figure 5F, 5214) (Column 18,

lines 47-56)

and a first digital signature, (Figure 5F, 5214)

the second audit record generated by the value dispensing device at an end of an audit

period including a value of at least one register maintained by the value

dispensing device at an end of the audit period (Figure 5F, 5214) (Column 18,

lines 47-56)

and a second digital signature; (Figure 5F, 5214)

means for processing the first audit record, the second audit record and usage data,

the means for processing the first audit record, the second audit record and usage

data being coupled to the interface circuit, the processing including

(i) verifying the first and second digital signatures; (Figure 5F, 5218)

(iv) generating a usage report for the value dispensing device based on the usage data if the determined difference correlates with the corresponding data provided in the usage data. (Column 62, lines 14-43)

64. Leon does not expressly show:

(ii) determining the difference between the value of the at least one register at the end of the audit period and the start of the audit period if the first and second digital signatures verify; (Columns 61-62, lines 51-13);

(iii) comparing the determined difference with corresponding data provide in the usage data (Column 46, lines 48-54)

65. However, Lertzman teaches usage data (“detail transaction data” [0075]) being compared to the difference between the value at the end of a period and the start of the period (“summary transaction data”). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Leon to include the validation as taught by Lertzman in order to verify the remittance is proper for the transactions completed (Lertzman, [0075]).

66. As to claim 29, the storage and later retrieval of a record previously sent is inherent to a system that compares the record to a later created one.

67. As to claim 30, Leon further shows:

the at least one register value in the first and second audit records includes an ascending register value. (Column 99, lines 37-41)

68. As to claim 31, Leon further shows:

the at least one register value in the first and second audit records includes a total piece count register value. (Column 100, lines 44-47)

69. As to claim 32, Leon further shows:

the first and second digital signatures are verified utilizing a public key. (Figure 5B, 536)

70. As to claims 42 and 43, Leon further shows:

The value dispensing device is a postage meter. (Title)

71. Claims 13-15, as understood by the Examiner, are alternately rejected under 35

U.S.C. §103(a) as being unpatentable over Leon and Lertzman as applied to claim 12 above, and further in view of Mosher (5,799,322).

72. As to claim 13, Leon further shows:

the first and second audit records each include a respective time stamp, (Column 18, lines 47-56)

Leon does not show:

verifying the time stamp in the first audit record corresponds to the start of the audit period;

and verifying the time stamp in the second audit record corresponds to the end of the audit period.

73. Mosher shows the verification of time stamps prior to accepting audit data (Columns 31-32, lines 66-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the invention of Leon to add time stamp validation, because this would further show that the data was valid for the audit period and not transactions outside of that time, as is done by Mosher (Column 32, 9-59).

74. As to claim 14, Leon further shows:

indicating an error in the processing of the usage data. (Figure 6F)

75. As to claim 15, Leon further shows:

the time stamp includes a date and a time (Column 18, lines 47-56)

76. Claims 26 and 27, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Leon and Lertzman as applied to claim 25 above, and further in view of Mosher (5,799,322).

77. As to claim 26, Leon further shows:

the first and second audit records each include a respective time stamp, (Column 18, lines 47-56)

78. Leon does not show:

verifying the time stamp in the first audit record corresponds to the start of the audit period; and

verifying the time stamp in the second audit record corresponds to the end of the audit period.

79. Mosher shows the verification of time stamps prior to accepting audit data (Columns 31-32, lines 66-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to have further modified the invention of Leon to add time stamp validation, because this would further show that the data was valid for the audit period and not transactions outside of that time, as is done by Mosher (Column 32, 9-59).

80. As to claim 27, Leon further shows:

indicating an error in the processing of the usage data if one of , the time stamp in the first audit record or the second audit record does not correspond. (Figure 6F)

35 U.S.C. § 112 6th Paragraph Analysis

81. Applicants have presented two “means phrases” in their claims. MPEP § 2181 I sets out a three prong analysis to determine if a phrase invokes the 6th paragraph of 35 U.S.C. §112 as follows:

82. “A claim limitation will be presumed to invoke 35 U.S.C. §112, sixth paragraph, if it meets the following 3-prong analysis:

- (A) the claim limitations must use the phrase “means for ” or “step for; ”
- (B) the “means for ” or “step for ” must be modified by functional language; and

- (C) the phrase “means for ” or “step for ” must not be modified by sufficient structure, material, or acts for achieving the specified function.”

83. This analysis is provided for the following “means phrases.”

Means Phrase 1

84. In claim 37, “means for processing the first audit record, the second audit record, and the usage data.”

- (A) The phrase recites "means for."
- (B) “Means for” is modified by the function “processing the first audit record, the second audit record, and the usage data.”
- (C) It is unclear whether there is structure, material, or acts for achieving the processing. See the rejection under 35 U.S.C. 112 2nd above.

85. This phrase is concluded **not** to invoke 35 U.S.C. § 112 6th Paragraph due to the issue with Prong (C).

86. While the limitation is concluded not to invoke 35 U.S.C. 112 6th Paragraph, the Examiner has completed the analysis to serve as an example in case Applicants believe other limitations should be interpreted under 112 6th paragraph.

87. The corresponding structure for Means Phrase 1, as stated by Applicants, is “a controller 44” and “software as described by the algorithm of Fig. 3.”

Means Phrase 2

88. In claim 37, “verifying the first and second digital signatures.”
- (A) The phrase does not recite "means for."
 - (B) The function “verifying the first and second digital signatures” is recited.
 - (C) It is unclear whether there is structure, material, or acts for achieving the processing. See the rejection under 35 U.S.C. 112 2nd above.
89. This phrase is concluded **not** to invoke 35 U.S.C. § 112 6th Paragraph.
90. While the limitation is concluded not to invoke 35 U.S.C. 112 6th Paragraph because it at least fails Prong (A), the Examiner has gone through the analysis because Applicants have argued that this is a means plus function limitation.
91. The corresponding structure for Means Phrase 2, if it properly invoked 35 U.S.C. 112 6th paragraph, although not clearly linked and associated, may be element 84 of Figure 3.

Response to Arguments

92. Applicant's arguments filed 24 March 2009 have been fully considered but they are not persuasive.

93. Applicants argue:

94. “As expressly detailed above, the specification clearly provides a basis for the claimed subject matter, which is described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention” (Remarks, Page 8, Paragraph 1).

95. Examiner's response:

96. Applicants have shown that there is no written description issue under 35 U.S.C. 112 1st paragraph. However, antecedent basis to the specification and written description are two separate issues. The Examiner objected to the specification for lack of antecedent basis under rule 37 C.F.R. 1.75(d)(1). In regards to antecedent basis for means plus function elements, MPEP § 2181 recites the following:

[J]ust because the disclosure provides support for a claim element does not mean that the USPTO cannot enforce its requirement that the terms and phrases used in the claims find clear support or antecedent basis in the written description[.]

97. Moreover, the Board of Patent Appeals and Interferences has identified the lack of antecedent basis in the specification as a significant problem. See 73 Fed. Reg. 32938, 32944 (June 10, 2008). Therefore, the Examiner is addressing the issue instead of potentially placing the burden on the Board of Patent Appeals and Interferences.

98. Applicants argue:

99. “In Items 12 and 13 of the Office Action, it is contended that claims 25-27, 29-32 and 43 claim both a system and a method. Applicants respectfully disagree. Claim 25 is directed to a data center that comprises an interface circuit and means for processing the first audit record, the second audit record and the usage data, where the processing includes (i) verifying..., (ii)

determining..., (iii) comparing ..., and (iv) generating... Thus, the processing includes each of these functions. Means plus function limitations are not method claims, and therefore claim 25 does not claim a method” (Remarks, Page 10, Paragraph 3).

100. Examiner's response:

101. The Examiner agrees that functional language that is part of a means plus function limitation does not make a claim a hybrid. However, as noted above, the limitation does not properly invoke interpretation under 35 U.S.C. 112 6th paragraph.

102. Applicants argue:

103. “Leon, in contrast is directed to a postage metering system in which an audit transaction is performed periodically to reset a timer” (Remarks, Page 13, Paragraph 2).

104. Examiner's response:

105. The Examiner agrees that Leon uses a timer to require an audit transaction. This timer establishes a period. The user is required to report the audit information before beginning the next period. Therefore, one audit report is required before the second period and another is required after the second period, if one was not already sent.

106. Applicants argue:

107. .”Thus, in Leon the system uses only a single audit record for the purpose of resetting a timer. There is no disclosure, teaching or suggestion in Leon of "receiving a second audit record

from the value dispensing device, the second audit record generated by the value dispensing device at an end of the audit period, the second audit record including a value of the at least one register maintained by the value dispensing device at the end of the audit period and a second digital signature" as is recited in claim 12" (Remarks, Page 14, Paragraph 1).

108. Examiner's response:

109. Each report in Leon contains register values from the dispensing device and is digitally signed, as admitted by Applicants (Remarks, Page 13, Paragraph 2). There is a report required after each period established through the timer. The timer is restarted after each report (Column 55, lines 6-30). Therefore, after each report, there is another period with another report after it.

110. Given these details, the Examiner interprets the report after a first period to be the first report. After the report, there is a second period, which the Examiner relies on as the period recited in the claims. After that period, another report is issued. This is the second report.

111. The register value for each report is the current value. Thus, the first report contains a register value before the period. Similarly, the second report contains a register value after the period.

112. Applicants have not established a special definition for the phrase "usage data" in their original disclosure. Therefore, the Examiner is to apply the broadest reasonable interpretation for the phrase. Accordingly, the Examiner has interpreted "usage data" as being data which is related to usage. With this interpretation, transmitting the STATUS message with the non-zero piece count and other values that change with the use of the dispensing device constitutes

sending usage data. If Applicants desire a specific meaning for the phrase “usage data” they are respectfully invited to add it to the claims. Doing so, may overcome the current art rejections.

113. Applicants other arguments have been addressed in the appropriate sections above.

Conclusion

114. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-3270. The Examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner’s supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Joshua Murdough
Examiner, Art Unit 3621

Application/Control Number: 10/606,507

Art Unit: 3621

Page 32

Paper - 20090605

/Calvin L Hewitt II/

Supervisory Patent Examiner, Art Unit 3685